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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,658	12/27/2001	Kyung-geun Lee	1293.1292	7011

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EXAMINER

HUBER, PAUL W

ART UNIT PAPER NUMBER

2653

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,658

Applicant(s)

LEE ET AL.

Examiner

Paul Huber

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11022004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2653

Applicant's election with traverse of Group II, claims 5-7, in the reply filed on October 27, 2004 is acknowledged. The traversal is on the ground(s) that: 1) "there have been no references cited to show any necessity for requiring restriction"; 2) "it is believed that classification is not conclusive on the question of restriction"; and 3) that "evaluation of both sets of claims would not provide an undue burden". This is not found persuasive.

Regarding the applicants' first grounds of traversal, it is the examiners position that references are not always required by the examiner to show the necessity for requiring restriction. Rather, for restriction to be proper, the different groups of inventions must have acquired a separate status in the art as was shown by their different classifications, and that the different groups of inventions must be shown to be distinct. Since the examiner has shown this without providing references, the requirement for restriction is deemed proper.

Regarding the applicants' second grounds of traversal, it was never the examiners contention that classification alone is conclusive on the question of restriction. Rather, the examiner must also show that the different groups of inventions are distinct. Since the examiner has shown this, the requirement for restriction is deemed proper.

Regarding the applicants' third grounds of traversal, the examiner has shown that a serious burden exists by the different groups of inventions having acquired a separate status in the art as shown by their different classifications. Therefore, the requirement for restriction is deemed proper.

The requirement is still deemed proper and is therefore made FINAL.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2653

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe et al. (USP-5,756,265).

Abe et al. discloses a method of recording data on an optical recording medium having a plurality of data recording/reproducing surfaces. See figure 6 which discloses an optical recording medium having a first recording/reproducing surface 62 and a second recording/reproducing surface 66. Data is recorded on a second recording/reproducing surface 66 that is farther from a light source than a selected first recording/reproducing surface 62 by using light having an intensity that is reduced by 6% less than a light intensity, P_r , used where recording data on the selected first recording/reproducing surface 62 among the plurality of recording/reproducing surfaces. See figures 1A & 1B, and col. 8, lines 45-56. However, "although in Example 1 discussed above, the intensity of the recording beam for recording information on the master disc for the second layer has been described as reduced relative to that of the recording beam for recording information on the master disc for the first layer, the intensity of the recording beam for recording information on the master disc for the second layer may be increased as compared with that of the recording beam for recording information on the master disc for the [first] layer provided that, depending on the conditions for manufacture of the optical disc and characteristics of the playback optical system the position of that portion of the waveforms reproduced from the second layer which corresponds to the minimum pit is lower than that from the first layer" (col. 10, lines 20-33).

Abe et al. discloses the invention as claimed, but fails to specifically teach that the intensity of light used to record data on the second recording/reproducing surface 66 is increased by 4-20% more than a light intensity, P_r , used where recording data on the selected first recording/reproducing surface 62. Note: Abe et al. teaches an intensity difference of 6%, but only with respect to the Example 1 where the intensity of the light is reduced for the second recording/reproducing surface 66 relative to the first recording/reproducing surface 62. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Abe et al. such that the intensity of light used to record data on the second recording/reproducing surface 66 is increased by 4-20% more than a light intensity, P_r , used where recording data on the selected first recording/reproducing surface 62. A practitioner in the art would have been motivated to do this under the circumstances that "the conditions for

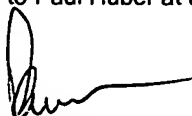
Art Unit: 2653

manufacture of the optical disc and characteristics of the playback optical system the position of that portion of the waveforms reproduced from the second layer which corresponds to the minimum pit is lower than that from the first layer" (col. 10, lines 29-33), as further taught be Abe et al..

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art of record considered as a whole fails to teach or suggest the method of independent claim 5 further including the limitation that the recording or reproducing on the selected data recording/reproducing surface is performed by using light having the intensity P_r emitted from one of two light sources included at opposite sides of the optical recording medium.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 703-308-1549.



Paul Huber
Primary Examiner
Art Unit 2653

pwh
February 28, 2005